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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/876,173
Filing Date: June 08, 2001
Appellant(s): RIZZI ET AL.

John M. Fleming
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed on October 31, 2,008 appealing from the last

Office Action mailed on August 08, 2,008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,804,659   Graham   10-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims **1-4, 8-9 and 11-40** are rejected under 35 U.S.C. 102(e) as being anticipated by

Graham, USP 6,804,659.

(In "no user profiling data are forwarded to the advertising server 140 for collection", **the**

advertising server 140 is an external advertising server or a third party advertising

server that should not collect or access the users' profile data. The claims will be

interpreted accordingly).

As per claims **1-4, 8-9 and 11-40**, Graham discloses, in one specific embodiment, a

method for targeting advertising to a user based upon content of an active document displayed in

a local browser on another computer or client computer. An active document can be one that is

presently displayed to a user, for example. However, in some embodiments, an active document

can be one that is being processed by a daemon or background process. The method includes

analyzing, by a server having a database coupled thereto, a network software such as a Servlet,

an applet or any other useful network loadable module, at least one document, displayed within a

local browser, to identify discussion of information corresponding to one or more user selectable

concepts of interest (the server determines whether the document is relevant to the user or

viewer). This analysis can provide a user concept relevance, which can comprise a measure of

relevance of the document to one or more concepts defined by the user (sending by the server a

signal or applet to the local browser to read or interpret textual content or document displayed

within to indicate a measure of relevance). The method can also include analyzing, the server

using a module, the document or textual content to identify discussion of information

corresponding to one or more advertiser selectable concepts of interest or advertiser's keywords

or keyword data stored in the server database (the server using the applet or network software or

module compares the advertiser's keywords to the characteristics of the document displayed in

the local web browser to determine whether an ad should be displayed within the browser). This

analysis can provide an advertiser concept relevance, which can comprise a measure of relevance

of the document to one or more concepts or keyword data defined by the advertiser. The method

can also include comparing the user concept relevance and the advertiser concept relevance for

the document to determine an overall relevance (factor). Next, the server selects an advertising or

ad matching the document or textual context characteristics (keywords) and the advertiser's

keyword data and the viewer's relevance factor (interest). In other words, selecting an

advertising or ad, from the server database, having a particular overall relevance can also be part

of the method or the process. The particular relevance can be the greatest relevance, least

relevance or within a range of greatest or least relevance, for example (the server compares using

a software or applet the user concept relevance and the advertiser concept relevance (keywords

or keyword data) for the document, displayed within the local web browser, to determine an

overall relevance and display an ad in the local web browser accordingly).

In another embodiment, a system for targeting advertising to a user based upon content

of one or more documents displayed to the user is provided. The system comprises a profile

content recognizer that analyzes contents of documents for information corresponding to one or

more user selectable concepts. The profile content recognizer provides an output of concepts

contained in the document that correspond to the one or more user selectable concepts. The

system also comprises an advertising content recognizer that analyzes content of documents for

information corresponding to one or more advertiser selectable concepts. A comparator

compares the output from the profile content recognizer and the output from the advertising

content recognizer and selects from a plurality of stored advertisements ones that are relevant to

the information contained in the documents based upon the comparison.

In a further embodiment, a computer program product for targeting advertising to users

based upon a content of one or more documents displayed to the user comprises code for

analyzing the documents to identify discussion of information corresponding to one or more user

selectable concepts of interest is provided. This code can provide a user concept relevance

indication, which can comprise a measure of relevance of the document to one or more concepts

defined by the user. Code for analyzing the documents to identify discussion of information

corresponding to one or more advertiser selectable concepts of interest is provided. This code

can provide an advertiser concept relevance indication, which can comprise a measure of

relevance of the document to one or more concepts defined by the advertiser. Code for

comparing the user concept relevance and the advertiser concept relevance for the document in

order to determine an overall relevance is also part of the product. Code for selecting advertising

having a particular overall relevance and a computer readable storage medium for holding the

codes are also part of the product. The particular relevance can be the greatest relevance, least

relevance, or within a range of greatest or least relevance, for example (col. 2: 64 to col. 3: 8).

(Here, the advertising server is part of the internal system and hence, the users' profile

data are not collected and provided to any third party or external advertising server, but rather are

collected and used internally for targeting the users).

Figs. 1-11; Col.1: 58 to col. 3: 44).

Please consider the entire reference.

(10) Response to Argument

Prior Art Rejection

First, Appellant's remarks regarding the 102 Rejection, based on Web Media article, and the 103 Rejection are being moot or have become null and void since the Examiner herein drops or withdraws such rejections.

Second, as featured on page 6 of the Appeal Brief, Appellant respectfully traverses the rejection of claims 1-4, 8-9 and 11-40, as being anticipated by Graham, and again objects to the narrow and improper reading of the claim language in the Action, i.e. "[i]n 'no user profiling data are forwarded to the advertising server 140 for collection', the advertising server 140 is an external advertising server or a third party advertising server that should not collect or access the user's profile data. The claims will be interpreted accordingly." (Office Action, pp. 4, 7, and 9). The Office Action, continues the Appellant, improperly narrows the claim language of independent claims 1, 21, 30, and 37, and thus all of the pending claims 1-4, 8-9, and 11-40, by requiring an advertising server that <u>must be external or a third party server</u> that should not collect or access a user's profile data and such a limitation in rejecting the claims is completely improper. For example, adds the Appellant, with respect to Appellant's claim 1, **an advertising server of various elements is recited and there is nothing in the claim language of claim 1, nor any other claim, to require that the advertising server be an "external advertising server or a third party advertising server" as required by the claims.**

Here, in response, the Examiner agrees with the Appellant that claims 7 and 10,

inadvertently reported as pending in the last Office Action, were previously canceled. Further,

contrary to the Appellant's findings, the Examiner's interpretation of the "wherein" clause, in

"wherein no user profile data is forwarded to the advertising", is read in light of the specification,

which recites in [0043] "A preferred embodiment performs the comparisons and determinations,

as well as displayed any corresponding banner ads in real time. As a consequence, data, which

might be used to profile the user, is not collected. No user profiling data is forwarded to the

advertising server 140 for collection, and any temporary information that might apply to privacy

concerns never leaves the user's computer 100, and such temporary information is destroyed

when the browser is closed." Additionally, the "wherein-clause" limitation may be considered as

an "Intended Use" recitation. Moreover, as shown below in response to the Appellant's specific

arguments, Graham teaches, in several embodiments, a system wherein no "user profile data" are

used to display an advertisement to a user reading or browsing a document displayed within the

user's local browser. Needless to say that, in those embodiments, that "no user profile data are

forwarded to the advertising server" (See col. 6: 27-47 and embodiments of figs. 1C and 11A-

11G). Thus, the Appellant's remarks regarding the "wherein-clause" limitation are not

convincing or have become moot or null and void here.

Third, as featured on pages 8-10 of the Appeal Brief, Appellant contends that Graham

fails to teach or suggest every feature of independent claims 1, 21, 30 and 37. For instance,

Appellant states that "Claim 1 recites, among other features, **"Wherein no user profiling data**

is forwarded to the advertising server." As recited in claim 1, continues the Appellant, at least

one applet reads textual content displayed on the web browser and the advertising server

compares the read textual content to keyword data to determine whether to display an ad

on the web browser and no (profile) data is forwarded to the advertising server. The

Graham's system, according to the Appellant, requires generation of a user profile file in order to

generate an advertisement for a user and that, under the Graham system, advertisements are only

displayed based upon the generated user profile file. Specifically, adds the Appellant, claim 1

recites, **"wherein no user profiling data is forwarded to the advertising server,"** recites

absolutely <u>nothing </u>as to the advertising server being of a third party or external. Therefore,

concludes the Appellant, because Graham fails to teach or suggest each and every feature of

claim 1 (and claims 21, 30 and 37, which include similar language as recited in claim 1),

withdrawal of the present rejection is respectfully requested and the claims are said to be

allowable or patentable over Graham (page 8 of the Appeal Brief).

In reply, the Examiner respectfully and completely disagrees with the Appellant's

findings. Indeed, with respect to argued claim 1, Graham explicitly or implicitly teaches a system

for providing Internet advertising (col. 1: 21-25) comprising an advertising server comprising a

web server 10 of fig. 1A having at least one applet or software (program or code) (col. 4: 64 to

col. 5: 5; **col. 12: 7-38**), said advertising server 10 further including a database 18 of fig. 1A or

database 19 of fig. 1B and a servlet (software) for sending said at least one applet to a web

browser RH 12c of fig. 1A on another computer 210 of fig. 2 (i.e. the advertising server 10 uses

a module/software or a servlet to send an applet (module/code) or signal to the web browser RH

12c of fig. 1A in order to read textual content displayed within the browser RH 12c of fig.

1A…..) (col. 5: 16-21; col. 5: 24-29; col. 12: 7-38; **col. 6: 27-47**) and receiving textual content

(such as (key)words or phrases) read **from a document 105 displayed within** said web browser

RH 12c of fig. 1A by said at least one applet (software, program or code) (**col. 6: 27-47; col. 12: 7-38**), said advertising server 10 of fig. 1A comparing said textual content to keyword data stored in said database 18 of fig. 1A (or database 19 storing advertisers' (key) words/phrases or concepts of relevance) to determine whether to display an ad on said web browser RH 12a of fig. 1B (**col. 6: 27-47; col. 12: 7-38**; col. 5: 46 to col. 6: 6; Figs. 1A-1B),

Wherein no user profiling data is forwarded to the advertising server 10 of fig. 1A (Here, no user profile is used to present the ad to the user, i.e. no user is forwarded to the server 10-col. 6: 27-47).

In general, Graham teaches an advertising server 10 of fig. 1A, having a database 18 storing advertisements indexed by concept (and advertising parameters, such as keywords**), from** advertisers. The server sends a signal to a web browser (RH Browser 12c), such as Netscape Navigator or Microsoft Internet Explorer, running on another computer or user's computer 210 of fig. 2 to receive textual content (document content) read therefrom or to receive keywords contained in a document displayed within RH Browser 12a or 12c of figs. 1A-1B (i.e. the advertising server uses a module/software or a servlet to send an applet (module/code) to the web browser in order to read textual content displayed within the browser). The server 10 compares, using a comparator or concept comparison coupled thereto, to compare the textual content or document content or keywords in the document content to keywords (keyword data) recorded in database 18 to determine whether to display an advertisement from the advertisements stored in database 18 of fig. 1A (See figs. 1A-1C, 2, 7 and 11A; col. 5: 16-29; col. 5: 46 to col. 6: 6; col. 6: 7-26; col. 6: 32-47; col. 6: 53-65; col. 10: 55-67; **col. 12: 7-38**; **col. 14: 61-67**; **col. 15: 1-23; col. 15: 59 to col. 16: 12).** Here, at least Bayesian belief network software is used as reasoning or

inference system (software/module) to perform identification of keywords in documents (col. 12: 7-38) preferably in conjunction with the Java based local RH Browser 12c running on the user's computer (Java software comprises useful applets or other codes such as plug-ins used by the browser to perform certain tasks or to browse documents col. 14: 61-67).

   In addition, contrary to the Appellant's contention, Graham teaches several embodiments that do not rely upon the user's profile to display an advertisement to the user and that do not require that the "user profile data" be forwarded to the advertising server 10. Rather, the advertisement is selected based on a match between the keywords or phrases found on a document (textual content) displayed within local RH Browser 12c and stored keywords (keyword data) or phrases (maintained in database 18 coupled to server 10 of fig. 1A). (See col. 6: 27-47, 1C and embodiments of figs.11A-11G). For example, Graham expressly discloses, as depicted in FIG. 1C, a first portion of an example document 105 viewable by a user. Document portion 105 includes several highlighted (key) words. Those highlighted words comprise a context that causes the display of a first advertisement 107, "Ad 345" because of the correspondence between the concepts in this advertisement and the concepts in the contents of the document portion 105 (because of a match between the highlighted keywords or keywords read from the displayed document and advertiser's keywords or stored keyword data). Later, the user views a new area of the document or document portion 109. Those highlighted words comprise a context that causes the display of a second advertisement 111, "Ad 938" because it is now the most relevant advertisement to the concepts being viewed by the user. If the use of only the highlighted words does not yield an advertisement with a sufficient relevancy score, R.sub.j, then other phrases contained in the viewing area can be used as the matching criteria for the

collection of advertising concepts useful in displaying one or more targeted advertisements to the

user (col. 6: 27-47 and fig. 1C; col. 15: 1-23and fig. 11A). It is worth noted that a document

(textual content) may come from an external source (see embodiments of figs 11A-11G; col. 15:

42-58; **col. 8: 1-13**). Please notice here that the number of documents that a user can request is so

big that it cannot be limited to server 10 and the prior art does not impose such a limitation.

However, the keywords and phrases useful in presenting the targeted ads are stored in the

(advertising) server 10.

Additionally, Appellant submits that dependent claim 23 recites, among other features,

"displaying no ad when said textual content does not match said keyword data" and argues that

Graham fails to teach or suggest that advertisements are not displayed when there is no textual

match to keyword data. However, the Examiner disagrees with the Appellant's finding. Indeed,

Graham discloses that if the use of only the highlighted words does not yield an advertisement

with a sufficient relevancy score, R.sub.j, then other phrases contained in the viewing area can be

used as the matching criteria for the collection of advertising concepts useful in displaying one or

more targeted advertisements to the user. Needless to say here, if there is no match between the

keywords (words) found in the displayed text and the stored keyword data and no appropriate

phrases are present, then no advertisements will be displayed. In other words, the concept of

displaying no advertisements if there is no match between the keywords (or phrases) is implicitly

supported in the reference (Col. 6: 27-47 and fig. 1C; col. 15: 1-23and fig. 11A). Failur e of

those skilled in the art to contemporaneously recognize an inherent property, function or

ingredient of a prior art does not preclude a finding of anticipation (MPEP 2131.01 (III).

Finally, and in general, Appellant submits that dependent claims 34, 35, 36 and 38 recite, contrary to Graham's teachings, **"wherein no data is collected to profile a user of the web browser"** in order to present an ad to the user (i.e. displaying an ad to the user based on the user's profile) and **"wherein no user profile data is forwarded to the advertising server".** However, contrary to the Appellant's contention, Graham teaches several embodiments that do not rely upon the user's profile to display an advertisement to the user and that do not require that the "user profile data" be forwarded to the advertising server 10. Rather, the advertisement is selected based on a match between the keywords or phrases found on a document (textual content) displayed within local RH Browser 12c and stored keywords (keyword data) or phrases (maintained in database 18 coupled to server 10 of fig. 1A). (See col. 6: 27-47, 1C and embodiments of figs.11A-11G)

Therefore, the Appellant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Appellant's arguments, as herein presented, are not convincing and thus, the Examiner's Action should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

10/26/09

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